

**REMARKS**

Claims 6 and 9-36 are pending, of which claims 26-31 are withdrawn from consideration.

In the Office Action identified above,<sup>1</sup> the Examiner:

- a) rejected claims 32 and 33 under 35 U.S.C. § 102(e) as being anticipated by Barge et al. (US 2005/0208322, "Barge");
- b) rejected claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Barge in view of Sato (US Patent No. 6,143,629, "Sato");
- c) allowed claims 9-25, 35, and 36; and
- d) objected to claim 6 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By the present amendment, Applicants have amended claims 32-34.

Claims 32 and 33 were rejected under 35 U.S.C. § 102(e) as being anticipated by Barge. Applicants respectfully traverse the rejection.

In order to properly establish that Barge anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

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<sup>1</sup> The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Barge fails to disclose each and every element recited in claims 32 and 33. In particular, Barge does not teach, at least, the claimed treatment method of a semiconductor wafer including “treating a semiconductor wafer which comprise a film constituting a device structure including a device pattern in a first solution including at least one kind of an oxidative acid and an oxidizing agent,” as recited in amended claims 32 and 33.

Applicants note that the Examiner stated, in Final Office Action mailed January 25, 2007, that Barge fails to disclose the formation of a device structure with a device pattern. See Final Office Action at page 3. Moreover, the Examiner asserted in the Response to Arguments section of the Office Action mailed June 14, 2007, that the “recitation comprise a film constituting a device structure including a device pattern has not been given patentable weight because the recitation occurs in the preamble.” Office Action at page 3. Therefore, Applicants have amended these claims to recite this element in the body of the claims. Accordingly, Applicants submit that amended claims 32 and 33 are allowable over Barge. The Examiner should withdraw the 35 U.S.C. § 102(e) rejection of claims 32 and 33.

Furthermore, objected-to claim 6 is also allowable at least due to its dependence from allowable base claim 32.

Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Barge in view of Sato. Applicants respectfully traverse this rejection, because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art reference (separately or in combination) must teach or suggest all the claim limitations. See

M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). “[I]n formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” *USPTO Memorandum* from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, p. 2. “[T]he analysis supporting a rejection ... should be made explicit” and it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed.” *Id.* (citing *KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007)).

A *prima facie* case of obviousness has not been established because, among other things, Barge and Sato, taken alone or in combination, fail to teach or suggest each and every element of amended claim 34.

Claim 34 was amended in a manner that is similar to claims 32 and 33. Specifically, claim 34 recites a combination including “treating a semiconductor wafer which comprise a film constituting a device structure including a device pattern in a first solution including at least one kind of an oxidative acid and an oxidizing agent.” Barge and Sato, taken alone or in combination, fail to teach or suggest at least this element of claim 34.

As noted above in regard to the Section 102 rejection, the Examiner previously admitted that “Barge fails to disclose the formation of a device structure with a device pattern.” Moreover, Sato, which was cited by the Examiner only for its disclosure of a 49% solution of HF (See Office Action at page 3), fails to cure this deficiency of Barge.

For at least the reason presented above, Barge and Sato, individually or in combination, do not teach or suggest each and every element of claim 34 and no *prima facie* case of obviousness has been established. The rejection of claim 34 under 35 U.S.C. § 103(a) should therefore be withdrawn.


In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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